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Docket 82800ADAN
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

James A. Truc, et al

CD INDEX PRINT LABEL

Serial No. 10/630,049

Filed July 30, 2003

Group Art Unit: 2851

Examiner: David M. Gray

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Commissioner for Patents

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Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

David Novais

Attorney for Appellants
Registration No. 33,324

David A. Novais/lid
Telephone: 585-588-2727
Facsimile: 585-477-1148

Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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Lisa DeMunck

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 8-40 which was contained in the Office Action mailed .

A timely Notice of Appeal was filed December 10, 2004.

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APPELLANT'S BRIEF ON APPEAL

I. Real Party In Interest

The real party in interest is Eastman Kodak Company, assignee of the inventor's entire interest.

II. Related Appeals And Interferences

Parent application US Serial No. 09/176,143 (Appeal No. 201-2214)

III. Status Of The Claims

Claims 8-40 stand finally rejected and are the subject of this appeal.

Claim 1-7 were canceled by the preliminary amendment filed on July 30, 2003.

IV. Status Of Amendments

No amendments were made to the claims after the final rejection of September 10, 2004.

V. Summary of Claimed Subject Matter

A. Independent claim 8 reads as follows:

8. A method for creating an index print label (Fig. 1, element 26) for a digital image storage disk (20), the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images (see page 3, lines 5-6 and Fig. 2, element 10);

storing the digital image data on a first surface (36) of a digital image storage disk (20), such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human (see page 2, lines 15-17; page 2, lines 26-28; page 3, lines 6-7; and Fig. 2, element 12); and

providing, on a second surface (34) of the digital image storage disk (20), positive images (28) which correspond to the digital image data, so that each of the positive images directly visually represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk (see page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12; and Figs. 1 and 2);

wherein:

said positive images (28) are provided on said digital image storage disk (20) so as to define a plurality of parallel rows on said disk (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.), at least a first row (i.e., row 1, with images 1-3) of said plurality of rows beginning at a first location (at image 1) on said disk and ending at a second location (at image 3) on said disk which is between said first location and a center axis (at hole 24) of said disk, such that said second location (at image 3) is on a first side of said center axis (at hole 24); and at least a second row (i.e., row 3 with images 13-20) of said plurality of rows beginning at a third location (at image 13) on said disk and ending at a fourth location (at image 20) on said disk that is opposite to said third location (at image 20), such that said fourth location is on a second side of said center axis (at hole 24) which is opposite to said first side.

B. Independent claim 11 reads as follows:

11. A digital image storage disk (20) comprising:

a first surface (36) containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface (36) of the digital image storage disk (20) are not readable by a human; and

an array of printed images (28) on a second surface (34) of the digital image storage disk (20), the printed images (28) corresponding to the plurality of photographic images stored on the first surface (36) of the digital image storage disk as said digital image data, said printed images (28) being

provided on said second surface (34) of the digital image storage disk so as to be viewable by a human while holding the digital image storage disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the digital image storage disk (see Figs. 1 and 2; page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12);

wherein:

said positive images (28) provided on said digital image storage disk (20) are provided on said disk so as to define a plurality of parallel rows (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.) on said disk, at least a first row (i.e., row 1, images 1-3) of said plurality of rows beginning at a first location (at image 1) on said disk that is in a vicinity of a first point on an outer perimeter of said disk and ending at a second location (at image 3) on said disk which is between said first location and a center axis (at hole 24) of said disk, such that said second location is on a first side of said center axis; and at least a second row (for example, row 3, images 13-20) of said plurality of rows beginning at a third location (at image 13) on said disk that is in a vicinity of a second point on the outer perimeter of said disk and ending at a fourth location (at image 20) on said disk that is opposite to said third location and is in a vicinity of a third point on the outer perimeter of the disk, such that said fourth location is on a second side of said center axis which is opposite to said first side.

C. Independent claim 15 reads as follows:

15. A digital image storage disk (20) comprising:

a first side which includes a first surface (36) adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface (34); and

an index print (26) provided on said second surface (34) of the disk, said index print (26) comprising a plurality of positive images (28) which visually directly represent the plurality of photographic images stored on the first surface of the disk as digital image data, said index print (26) being provided on said second surface (34) of said disk so that said plurality of positive images are viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk (see page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12, and Figs. 1 and 2);

wherein:

said positive images (28) provided on said digital image storage disk are provided on said disk so as to define a plurality of parallel rows on said disk (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.), at least a first row (i.e. row 1, images 1-3) of said plurality of rows beginning at a first location (at image 1) on said disk and ending at a second location (at image 3) on said disk which is between said first location and a center axis (at hole 24) of said disk, such that said second location is on a first side of said center axis; and at least a second row (i.e. row 3, images 13-20) of said plurality of rows beginning at a third location (at image 13) on said disk and ending at a fourth location (at image 20) on said disk that is opposite to said third location, such that said fourth location is on a second side of said center axis which is opposite to said first side.

D. Independent claim 19 reads as follows:

19. A method for creating an index print label (26) for a digital image storage disk (20), the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images (page 3, lines 5-6; Fig. 2, element 10);

storing the digital image data on a first surface (36) of a digital image storage disk (20), such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are

not readable by a human (page 2, lines 15-17; page 2, lines 26-28; page 3, lines 6-7; Fig. 2, element 12); and

providing, on a second surface (34) of the digital image storage disk (20), positive images (28) which correspond to the digital image data, so that each of the positive images directly represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk (see page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12, and Figs. 1 and 2);

wherein:

said positive images (28) are provided on said digital image storage disk so as to define a plurality of rows on said disk (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.), and at least two orthogonal planes extend along a center axis (at hole 24) of said disk, at least a first row (i.e. row 1, images 1-3) of said plurality of rows defines a first longitudinal axis which is perpendicular to one of said orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, and at least a second row (i.e. row 3, with images 13-20) of said plurality of rows defines a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on said one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

E. Independent claim 22 reads as follows:

22. A digital image storage disk (20) comprising:

a first surface (36) containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface (36) of the digital image storage disk (20) are not readable by a human; and

an array of printed images (28) on a second surface (34) of the digital image storage disk (20), the printed images (28) corresponding to the plurality of photographic images stored on the first surface (36) of the digital

image storage disk as said digital image data, said printed images being provided on said second surface (34) of the digital image storage disk so as to be viewable by a human while holding the digital image storage disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the digital image storage disk (page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12 and Figs. 1 and 2);

wherein:

said positive images (28) are provided on said digital image storage disk so as to define a plurality of rows on said disk (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.), and at least two orthogonal planes extend along a center axis (at hole 24) of said disk, at least a first row (i.e. row 1, with images 1-3) of said plurality of rows defines a first longitudinal axis which is perpendicular to one of said orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, and at least a second row (i.e. row 3, with images 13-20) of said plurality of rows defines a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on said one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

F. Independent claim 26 reads as follows:

26. A digital image storage disk (20) comprising:

a first side which includes a first surface (36) adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface (34); and

an index print (26) provided on said second surface (34) of the digital image storage disk, said index print (26) comprising a plurality of positive images (28) which correspond to the plurality of photographic images stored on the first surface of the digital image storage disk as digital image data, said index

print (26) being provided on said second surface (34) of said digital image storage disk so that said plurality of positive images are viewable by a human while holding the digital image storage disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the digital image storage disk (page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12 and Figs. 1 and 2);

wherein

said positive images (28) are provided on said digital image storage disk so as to define a plurality of rows on said disk (Fig. 1, i.e., row 1 with images 1-3, row 2 with images 7-9, row 3 with images 13-20, etc.), and at least two orthogonal planes extend along a center axis (at hole 24) of said disk, at least a first row (i.e., row 1, images 1-3) of said plurality of rows defines a first longitudinal axis which is perpendicular to one of said orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, and at least a second row (i.e. row 3, with images 13-20) of said plurality of rows defines a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on said one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

G. Independent claim 30 reads as follows:

30. A method for creating an index print label (26) for a digital image storage disk (20), the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images (page 3, lines 5-6, Fig. 2, element 10);

storing the digital image data on a first surface of a digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human (page 2, lines 15-17; page 2, lines 26-28; page 3, lines 6-7; Fig. 2, element 12); and

providing, on a second surface (34) of the digital image storage disk (20), positive images (28) which correspond to the digital image data, so that

each of the positive images directly represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk (see page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12 and Figs. 1 and 2);

wherein at least two orthogonal planes are defined along a center axis (at hole 24) of said disk, at least a first positive image (i.e., images 1-3, 7-9, 13-16, 21-23, 28-30) of said positive images being located on a first side of one of said orthogonal planes, and at least a second positive image (i.e., images 4-6, 10-12, 18-20, 25-27, 31-33) of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

H. Independent claim 33 reads as follows:

33. A digital image storage disk (20) comprising:

a first surface (36) containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface (36) of the disk (20) are not readable by a human; and

an array of printed images (28) on a second surface (34) of the disk (20), the printed images (28) corresponding to the plurality of photographic images stored on the first surface (36) of the disk as said digital image data, said printed images (28) being provided on said second surface (34) of the disk so as to be viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk (see page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12 and Figs. 1 and 2);

wherein at least two orthogonal planes are defined along a center axis (at hole 24) of said disk, at least a first positive image (i.e., images 1-3, 7-9, 13-16, 21-23, 28-30) of said positive images being located on a first side of one of said orthogonal planes, and at least a second positive image (i.e., images 4-6, 10-

12, 18-20, 25-27, 31-33) of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

I. Independent claim 37 reads as follows:

37. A digital image storage disk (20) comprising:

a first side which includes a first surface (36) adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface (34); and

an index print (26) provided on said second surface (34) of the disk, said index print (26) comprising a plurality of positive images (28) which correspond to the plurality of photographic images stored on the first surface of the disk as digital image data, said index print (26) being provided on said second surface (34) of said disk so that said plurality of positive images are viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk (page 2, lines 18-22; page 2, line 28 to page 3, line 1; page 3, lines 10-12; and Figs. 1 and 2);

wherein at least two orthogonal planes are defined along a center axis (at hole 24) of said disk, at least a first positive image (i.e., images 1-3, 7-9, 13-16, 21-23, 28-30) of said positive images being located on a first side of one of said orthogonal planes, and at least a second positive image (i.e., images 4-6, 10-12, 18-20, 25-27, 31-33) of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

VI. Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection for review are:

(1) The rejection of claims 8-40 under 35 USC 103(a) as being unpatentable over Kahle in view of Kraft et al.;

(2) The rejection of claims 8-40 under 35 USC 103(a) as being unpatentable over Otake et al., Ishikawa et al. and Wess.

VII. Arguments

A. The rejection of claims 8-40 under 35 USC 103(a) as being unpatentable over Kahle in view of Kraft et al.

i. Argument for independent claim 8.

Claim 8 requires a method for creating an index print label for a digital image storage disk. The method of claim 8 comprises the steps of digitizing images to produce digital image data; storing the digital image data on a first surface of the digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the disk are not readable by a human; and providing, on a second surface of the disk, positive images that correspond to the digital image data so that each of the positive images directly digitally represent the photographic images stored on the disk, and the positive images are provided on the second surface so as to be viewable by a human while holding the disk. Claim 8 further requires that the positive images be provided on the disk so as to define a plurality of parallel rows on the disk, with at least a first row of the plurality of rows beginning at a first location on the disk and ending at a second location on the disk that is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis; and at least a second row of the plurality of rows beginning at a third location and ending at a fourth location on the disk that is opposite to the third location, such that the fourth location is on a second side of the center axis which is opposite to the first side.

The reference to Kahle was cited to show a method and apparatus for printing a disk label for a CD. The reference to Kahle discloses an arrangement wherein title information which identifies the digital information that is recorded on a medium is provided on the medium. Claim 8 requires that positive images which directly visually represent the digital photographic images stored on the image storage disk be provided on the surface of the disk. This feature is not shown or suggested in the reference to Kahle. As described in

column 1 of Kahle, conventionally the labeling of CDs includes the manual writing of information on the label and attaching the label to the disk which tends to be time consuming. This discussion of the background of Kahle suggests that the reference to Kahle is not directed to the concept of directly and/or visually replicating on a label, in a manner which can be readable by a human, a photographic image which directly represents the digital photographic image information stored on the disk. The reference to Kahle is essentially directed to providing identifying information which can identify, in general, the subject matter of the information on the disk. As described in column 2 of Kahle, in at least one embodiment of the method of Kahle a title data stream is used to form title information. In a further embodiment of Kahle, a label having title information can be produced from a second data stream produced independently of a first data stream. Therefore, the problem addressed in Kahle with respect to manually writing information on the disk, and the solution as proposed by Kahle with regard to the creation of title information, does not contemplate or suggest that the information in Kahle is to be positive images which directly represent or replicate in a visual manner information which is stored in digital form on the disk.

The reference to Kraft et al. was cited to show the concept of an index print, however, the reference to Kraft et al. does not correct the deficiencies of Kahle with respect to the present invention. More specifically, the reference to Kraft et al discloses a method of producing an index print for identifying images for reprints instead of utilizing a negative. There is no disclosure or suggestion in Kraft et al. that would suggest that the index print as disclosed by Kraft et al. can be applied to a CD or disk in the manner as claimed, such that digital image information is provided on one surface of the disk, and positive images which directly represent the digital information is provided on the second surface of the disk. Further, absent Applicants' disclosure, one having ordinary skill in the art would not have combined the above-noted references to achieve the claimed invention, since neither reference shows or suggests the specific method of the claimed invention.

In essence, the reference to Kahle relates to the concept of providing a label on CD. The label may include title information that identifies the information recorded on the CD, the name of a particular database file recorded on the CD or a brief description of the type of information recorded on the CD. Each of the above categories describe the contents of the CD or disk in a

general nature, and does not provide for the replication of the information that is on the CD or disk in the manner in which the positive index images in accordance with the present invention provides a replication of the digital data image information stored on the disk. With respect to Kahle, title information relative to databases and descriptions could be the same for several CDs and is not of the nature where the information stored on the disk is replicated.

Kraft et al., as noted above, relates to a method of producing index prints. As described in Kraft et al., the index print can be a paper print that contains a plurality of small images that belong to different frames on a negative film, and can be used to identify a frame and order reprints. As noted above, there is no disclosure or suggestion in Kraft et al. that suggests that the index print as disclosed by Kraft et al. can be applied directly to the surface of a disk in the manner as claimed; such that the positive images on the index print directly represent or replicate the digital information stored on the disk. That is, the reference to Kahle discloses the concept of providing a general label on a disk, while the reference to Kraft et al. relates to a basic index print that is provided on a separate sheet. If the teaching of Kraft et al. were applied to Kahle, the teaching would be that an index print representative of the CD can be created separate from the CD. However, absent Applicants' disclosure, one of ordinary skill in the art would not have provided for the specific feature of the present invention where positive images are applied to a surface of a disk in the manner that the positive images directly represent the digital information stored on a second surface of the disk. Neither Kahle or Kraft et al. show or suggest this specific feature of the present invention.

Further, in the present invention since the positive images are to be provided on a disk which has a specific shape, structure and geometry, the present invention illustrates a layout of the positive images on the disk in a manner which permits a user to view the positive images while holding the disk, and also efficiently and effectively utilizes the space on the disk. That is, Claim 8 further requires that the positive images be provided on the disk so as to define a plurality of parallel rows, with at least a first row beginning at a first location on the disk and ending at a second location on the disk that is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis; and at least a second row of the plurality of rows beginning at a third location on the disk and ending at a fourth location on the disk that is opposite to the third location, such that the fourth location is on a second side of the center

axis which is opposite to the first side. The applied references are not believed to show or suggest the specific features of the positive images on the disk as noted above, in combination with the digital image storage disk as required by the claimed invention.

In the paragraph bridging pages 2 and 3 of the Final Rejection dated September 10, 2004, it is suggested that the layout of the positive images is "printed matter". Applicants disagree for the following reasons. First, claim 8 is clearly directed to a method of creating an index print label for a digital image storage disk. Each of the index print label and the digital image storage disk clearly refer to an article of manufacture. Moreover, in the present case, the positive images are provided on the digital image storage disk in a specific manner to (1) permit a viewing of the positive images while holding the disk; (2) permit a user to clearly identify what images are digitally stored on the disk; and (3) effectively use the surface area of the disk which has a specific structure. Therefore, in the claimed invention there is a relationship between the positive images and the digital image disk upon which they are attached or placed. Further, the present invention with respect to the layout of the images on the disk provides for a faster and easier way to identify the images that are stored on the disk in the form digital image data. Therefore, with respect to the method of the present invention, it is clear that the method of creating an index print label with positive images for a digital image storage disk as claimed provides for a useful, concrete and tangible result. Accordingly, it is believed that the specific features of the present invention with respect to the layout of the positive images should be considered and is clearly not shown, suggested or contemplated in the applied references. It is further noted that the claims require the combination of the index print having positive images thereon and a digital image storage disk, with the positive images being provided on the disk in a manner that facilitates the viewing of the images, and that the positive images directly represent the digital information on the disk. Therefore, the features as required by the claimed invention with respect to the positioning of the images on the disk are patentable features which are not shown, suggested or contemplated in the applied references.

Further with regard to the claimed features of the rows of positive images on the disk, reference is made to In re Gulack, 703F. F2d 1381 (Fed. Cir. 1983), where it was held that the difference between an invention and the prior art cited against it cannot be ignored because those differences reside in the content

of the printed matter. In Gulack, the invention consisted of (1) a band, a ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed. Id at 1387. The prior rejection in Gulack was premised upon the fact that a circular band with items printed upon it was well known in the art. See Id at 1384. In Gulack the Court concluded that the numbers printed on the band should be considered since they had a functional relationship to the band itself, and that the digits exploit the endless nature of the band. See Id at 1386-87. Comparing this with the present invention, it is noted that in the present invention the positive images and the specific manner in which the positive images are provided on the disk achieve the purpose of permitting a person to immediately identify what images are stored on the disk while holding the disk. Also, the specific layout of the images on the disk as claimed exploit the physical nature of the disk, and the provision of the positive images on the disk overcome the stated problem of index prints being separated from the medium which includes the images. Therefore, consistent with the finding in Gulack, in the present invention a relationship exists between the positive images and the disk, and further, the differences between the pending claims and the proposed combination of references with regard to the layout of the positive images on the disk is such that the applied references, whether considered individually or in combination, do not show or suggest positive images on a disk in the specific manner required by the claimed invention.

Accordingly, claim 8 is believed be allowable over the references to Kahle and Kraft et al., whether these references are considered individually or in combination.

ii. Argument for dependent claims 9-10.

Claims 9-10 depend from claim 8 and set forth further unique features of the present invention which are also not believed to be shown or suggested in the applied references. Each of claims 9-10 set forth additional features of the positive images with respect to providing them on the digital image storage disk. More specifically, each of claims 9 and 10 require that the positive images be provided on a first portion of the second surface of the disk and that indicia is provided on a second portion of the second surface of the disk as shown in Fig. 1. Further, claim 9 requires that the images be printed directly on the disk,

while claim 10 requires that the images be provided on a label that can be adhered to the disk. Thus, each of claims 9 and 10 further elaborate on the feature of providing images on the disk, and require the provision of indicia separate from the positive images on the disk. None of the applied references, whether considered individually or in combination, are believed to show or suggest the specific combination of features required by claims 9 and 10. More specifically, as noted above, the references to Kahle discloses an arrangement that provides for title information on a medium. The reference to Kraft et al. discloses a method for producing an index print for identifying images. None of the applied references, whether considered individually or in combination, disclose the specific combination of positive images that represent digital information stored on the disk being provided on a first portion of the disk, and indicia being provided on a second portion of the disk.

Accordingly, Kahle and Kraft et al., whether considered individually or in combination, are not believed to anticipate or make obvious the specific features required claims 9-10.

iii. Argument for independent claim 11.

Independent claim 11 relates to a digital image storage disk that comprises a first surface containing digital image data representing a plurality of photographic images, such that the images represented by the data stored on the first surface of the disk are not readable by a human; and an array of printed images on a second surface of the digital image storage disk, with the printed images corresponding to the plurality of images stored on the first surface of the disk as the digital image data. As further required by claim 11, the printed images provided on the second surface of the disk are provided thereon so as to be viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk. Claim 11, like claim 8 sets forth that the images are provided so as to define a plurality of parallel rows on the disk, with at least a first row of the plurality of rows beginning at a first location on the disk that is in the vicinity of a first point on an outer perimeter of the disk, and ending on a second location on a disk which is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis. Claim 11 further requires that at least the second row of the plurality of rows begins at a third location on

the disk that is a vicinity of a second point on the outer perimeter of the disk, and ends at a fourth location on a disk that is opposite to the third location and is in a vicinity of a third point on the outer parameter of the disk, such that the fourth location is on a second side of the center axis which is opposite to the first side.

The references to Kraft et al. and Kahle, whether considered individually or in combination, are not believed to show or suggest the specific elements of the digital storage disk are required by claim 11. More particularly, as indicated above, the reference to Kahle relates to the concept of providing a label on a CD, which label may include title information that identifies the information recorded on the CD, the name of a particular database file recorded on the CD or a brief description of the type of information recorded on the CD. Each of the above categories describes the contents of the CD or disk in a general nature, and does not provide for the replication of the information that is on the CD or disk in the manner in which the positive images in accordance with the present invention provides for a replication of the digital image data information stored on the disk. The reference to Kraft et al. as discussed above with respect claim 1 does not correct the deficiencies of Kahle with respect to the claimed invention. More specifically, the reference to Kraft et al. relates to an index print that can be a paper print and contains a plurality of small images, however, there is no disclosure or suggestion in Kraft et al. that suggests that the index print as disclosed can be applied to the surface of the CD or disk in the manner as claimed; such that the positive images on the index print directly represent or replicate the digital information provided on the disk. Further, as discussed above with regard to claim 1, claim 11 set forth specific features of the arrangement or layout of the positive images on the disk in a manner that permits a viewing of the positive images while holding a disk, permits a user to clearly identify what images are digitally stored on the disk; and effectively utilizes the surface area of the disk. As also discussed above, there is a clear relationship between the positive images and the digital image storage disk upon which they are attached or placed, and the specific layout of the images on the disk as claimed exploit the physical nature of the disk. This specific layout as claimed is not believed to be shown or suggested in the references to Kahle and Kraft et al., whether these references are considered individually or in combination.

Accordingly, Kahle and Kraft et al., whether considered individually or in combination, are not believed to anticipate or make obvious the specific features required by claim 11.

iv. Argument for dependent claims 12-13.

Dependent claims 12-13 set forth further unique features of the disk of claim 12. More specifically, claim 12 requires that the array of printed images be printed directly onto a first portion of the second surface of the disk and that indicia be provided on a second portion of the second surface of the disk. Claim 13 requires that the photographic images be printed on a label sticker that is affixed to a first portion of the second surface of the disk, and that indicia be provided on a second portion of the second surface of the disk.

The applied references, whether considered individually or in combination, are not believed to show or suggest the specific combination of images being printed on a first portion of a disk and indicia being provided on a second portion of a disk in the manner as required by claims 12 and 13.

v. Argument for dependent claim 14.

Claim 14 sets forth a further feature of the disk wherein each image in the array contains an image number that corresponds to a location of the digital image data on a disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific feature of a disk having positive images thereon, wherein an image number that corresponds to a location of the digital image data on the disk as provided for each image.

vi. Argument for independent claim 15.

Independent claim 15 relates to digital image storage disk that comprises a first side for digital information, a second side opposite the first side and an index print provided on a second surface of the second side. The index print includes a plurality of positive images that visually directly represent the plurality of photographic images stored on the first surface of the disk. Claim 15 further requires that the positive images are provided on the disk so as to define a plurality of rows, with at least a first row of the plurality on rows beginning at a first location on the disk and ending at a second location of the disk which is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis, and at least a second row of the

plurality of rows beginning at a third location on the disk and ending at a fourth location on the disk that is opposite to the third location, such that the fourth location is on a second side of the center axis which is opposite to the first side.

As noted above, the applied references to Kahle and Kraft et al., whether considered individually or in combination, are not believed to show or suggest the specific combination of features required by claim 15. More specifically, the reference to Kahle is related to providing a general label on a CD, while the reference to Kraft et al. relates to a method of producing an index print. Absent Applicants' disclosure, there would be no teaching or suggestion in either Kraft et al. and Kahle of the specific combination of a disk having digital information on one side and an index print with positive images that replicate the digital information on a second side so as to be viewable by a human while holding the disk. Further, the applied references, whether considered individually or in combination, do not show or suggest the above in combination with the specific layout or arrangement of the positive images on the disk as required by claim 15 and discussed above with regard to claims 1 and 11. As set forth above with regard to claim 1, the layout or arrangement of the positive images have a functional relationship to the disk itself and is a claimed feature which is not believed to be shown or suggested in the applied references.

Accordingly, Kahle and Kraft et al., whether considered individually or in combination, are not believed to show or suggest the features of claim 15.

vii. Argument for dependent claim 16.

Claim 16 depends from 15 and sets forth a further unique feature of the index print. More specifically, claim 16 requires that the index print define an arcuate shape. This specific features takes advantage of the geometry of the disk.

The features of claim 16 are not believed to be shown or suggested in the applied references. Therefore, claim 16 is believed to be allowable.

viii. Argument for dependent claims 17-18.

Claim 17 requires that the index print be adhered to a surface of the disk, while claim 18 requires that the index print be printed directly onto the surface of the disk. The applied references, whether considered individually or in

combination, are not believed to show or suggest the claimed feature of an index print with positive images thereon that is adhered or printed directly on the disk in the manner as required by claims 17 and 18.

Accordingly, claims 17 and 18 are also believed to be allowable.

ix. Argument for independent claim 19.

Claim 19 relates to a method for creating an index print label for a digital image storage disk. The method of claim 19 requires the steps of digitizing photographic images to provide digital image data representative of the image; storing the data on a first surface of the disk; and providing on a second surface of the disk positive images that correspond to the data so that each of the positive images directly represent the images stored on the disk and are viewable by a human while holding the disk. Claim 19 further requires that the positive images be provided on the disk so as to define a plurality of rows on the disk, with at least two orthogonal planes extending along a center axis of the disk. At least the first row of the plurality of rows defines a first longitudinal axis which is perpendicular to one of the orthogonal planes, with the first row beginning and ending on one side of the one orthogonal plane; and at least the second row of the plurality of rows defines a second longitudinal axis which is perpendicular to the one orthogonal plane, with the second row beginning on one side of the one orthogonal plane and ending on an opposite side of the one orthogonal plane.

The general features of the references to Kahle and Kraft et al. have been discussed above with regard to claim 1. As discussed above, the reference to Kahle discloses the basic provision of a label on a CD, while the reference to Kraft et al. discloses the utilization of an index print. There is no suggestion or teaching in the references for providing positive images on a disk in the manner as required by claim 19. Further, both the references to Kahle and Kraft et al., whether considered individually or in combination, do not show the layout or arrangement of the positive images with respect to the plurality of rows, and their relationship with regard to the orthogonal planes that extend along the center axis of the disk. As noted above with regard to claim 1, the specific layout or arrangement of the images have a relationship to the digital image disk onto which the images are placed or attached, and the specific layout exploits the physical nature of the disk.

The references to Kahle and Kraft et al, whether considered individually or in combination, are not believed to show or suggest the specific combination of features required by claim 19 with regard to providing digital information on one side of the disk, providing positive images on a second side of the disk that represents the digital information, and arranging the images in the specific manner on the surface of the disk as required by claim 19.

Accordingly, Kraft et al. and Kahle, whether considered individually or in combination, are not believed to show or suggest the features of claim 19.

x. Argument for dependent claims 20 and 21.

Claims 20 and 21 depend from claim 19 and set forth further features with regard to placing the images on the disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific method of placing images on a disk (wherein the images represent positive images of digital information stored on the disk) as required by claims 20-21. Accordingly, these claims are also believed to be allowable.

xi. Argument for independent claim 22.

Claim 22 relates to a disk that includes a first surface with digital image information and a second surface with an array of printed images that correspond to the digital information. Claim 22 further requires the layout or arrangement of the images on the disk in a manner similar to claim 19.

The features of the reference to Kahle and Kraft et al. have been discussed above. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific features of a disk having a first surface with digital information and a second surface with positive images that correspond to the digital information, as well as the arrangement of the images on the disk in the manner as required by claim 22.

Accordingly, Kraft et al. and Kahle, whether considered individually or in combination, are not believed to show or suggest the features of claim 22.

xii. Argument for dependent claims 23-24.

Claims 23-24 set forth further unique features of the present invention which are also not believed to be shown or suggested in the applied references. More specifically, claims 23-24 set forth features of printing the images directly on the disk or on a label sticker that is affixed to the disk. The above features in combination with the features set forth in claim 22 are not believed to be shown or suggested in the applied references. Therefore, claims 23-24 are believed to be allowable.

xiii. Argument for dependent claim 25.

Claim 25 relates to each image in the array containing an image number that corresponds to a location of the image data on the disk. The applied references are not believed to show or suggest the features of claim 25 in combination with the features of claim 22 as noted above. Therefore, claim 25 is believed to be allowable.

xiv. Argument for independent claim 26.

Claim 26 relates to a disk that has a first side with digital information and a second side with a second surface. Claim 26 further requires that an index print be provided on the second surface of the disk, with the index print having a plurality of positive images that correspond to the images that are stored on the first surface of the disk. Claim 26 further requires that the positive images be arranged in a manner similar to claim 22 with regard to the images being in a plurality of rows, with one of the rows beginning and ending on one side of the an orthogonal plane through the center of the disk, and a second row extending to both sides of the orthogonal plane.

For the reasons noted above, the applied references to Kahle and Kraft et al. are not believed to show or suggest the combination of a disk with a first side that includes digital data, a second side that includes an index print with positive images that correspond to the digital data, and an arrangement of the positive images on the disk so as to define a plurality of rows, with a first row being on one side of an orthogonal plane that extends through the center of the disk, and a second row extending to both sides of the orthogonal plane.

Accordingly, claim 26 is believed to be allowable over Kahle and Kraft et al., whether considered individually or in combination.

xv. Argument for dependent claim 27.

Claim 27 sets forth a further feature with respect to the index print and requires that the index print define an arcuate shape. This feature, in combination with the features of claim 26 is not shown or suggested in the applied references.

xvi. Argument for dependent claims 28-29.

Claim 28 sets forth that the index print is adhered to the second surface of the disk, and claim 29 sets forth that the index is printed directly on the second surface of the disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the further features of claims 28-29.

xvii. Argument for independent claim 30.

Claim 30 relates to method of creating an index print label for a digital image storage disk. The method of claim 30 requires digitizing photographic images to produce digital image data; storing the digital image data on a first surface of the disk; and providing positive images on a second surface of the disk that correspond to the digital image data. Claim 30 further requires that at least two orthogonal claims be defined along a center axis of the disk, with at least a first positive image being located on a first side of one of the orthogonal planes, and at least a second positive image being on a second side of the one orthogonal plane that is opposite to the first side.

The specifics of Kahle and Kraft et al. and their relationship to the subject matter of the present invention has been discussed above. It is noted that the references to Kahle and Kraft et al. do not show or suggest the claimed features of the present invention, including the combination of providing digital data on one surface of the disk, providing positive images on a second surface of the disk that correspond to the digital data, and arranging the positive images on the disk, with respect to an orthogonal plane along a center axis of the disk, in a

manner in which a first positive image is on one side of the orthogonal plane, and a second positive image is on a second side of the orthogonal plane.

Accordingly, Kahle and Kraft et al, whether considered individually or in combination, are not believed to show or suggest the features of claim 30.

xviii. Argument for dependent claims 31-32.

Dependent claims 31-32 require a specific method for printing or providing the images on a disk. Claim 31 requires that the images be printed directly on the disk while claim 32 requires that the images be provided on a label sticker and adhered to the disk. The features of claims 31-32 are not believed to be shown or suggested in the applied references.

xix. Argument for independent claim 33.

Claim 33 relates to a digital image storage disk which includes a first surface that contains digital image data representing a plurality of photograph images; and an array of printed images on a second surface of the disk, with the printed images corresponding to the plurality of photographic images stored on the first surface of the disk as digital image data and being provided so as to be readable by a human while holding the disk. Claim 33 further requires that the images be arranged so that a first image can appear on one side of an orthogonal plane and a second image can appear on a second side of the orthogonal plane.

The references to Kahle and Kraft et al., whether considered individually or in combination, are not believed to show or suggest the specific features of claim 33. The particulars of the references to Kahle and Kraft et al. are discussed with reference to claim 1. With regard to claim 33, the references to Kahle and Kraft et al. do not show or suggest the combination of a disk that has digital image data on a first surface; an array of printed images on a second surface (where the printed images are a replication of the digital data); and an arrangement of the images on the surface of the disk, such that at least one of the images is on a first side of an orthogonal plane defined along a center axis of the disk, and at least a second image is on second side of the orthogonal plane.

Accordingly, claim 33 is believed to be allowable over the references to Kahle and Kraft et al.

xx. Arguments for dependent claims 34-35.

Claim 34 relates to the images being printed directly on the disk, while claim 35 relates to the feature of the images being provided on a label sticker that is affixed to the disk. These claims set forth further features with regard to the placement of the images on the disk that are not believed to be shown or suggested in the applied references. Therefore, claims 34-35 are also allowable.

xxi. Argument for dependent claim 36.

Claim 36 relates to the feature of each image having an image number that corresponds to a location of the digital image data on a disk. The applied references are not believed to show or suggest the features of claim 36.

xxii. Argument for independent claim 37.

Independent claim 37 relates to digital image storage disk that includes a first side with digital image data and a second side that has a surface onto which an index print having a plurality of positive images is provided. The plurality of positive images correspond to the digital image data on the disk. Claim 37 further requires an arrangement of the images on the disk where at least a first image is on one side of an orthogonal plane that is defined along a center axis of the disk, and a second image is on an opposite side of the orthogonal plane.

The references to Kahle and Kraft et al. are not believed to show or suggest the specific combination of features required by claim 37, including the concept of having a disk with a first side with digital image data, a second side with an index print that includes positive images that correspond to the digital data, and an arrangement of the images on the disk so that at least one image is on a first side of an orthogonal plane defined along the center of the disk, and at least a second image is on a second side of the orthogonal plane.

Accordingly, Kahle and Kraft et al, whether considered individually or in combination, are not believed to show or suggest the features of claim 37.

xxiii. Argument for dependent claim 38.

Claim 38 requires that the index print define an arcuate shape. The applied references are not believed to show or suggest the specific combination of features with regard to claim 38 and claim 37 from which claim 38 depends.

xxiv. Argument for dependent claims 39-40.

Claims 39-40 set forth different features with respect to the index print either being adhered to the surface of the disk or being printed directly onto the surface of the disk. The applied references are not believed to show or suggest the combination of an index print with positive images, wherein the positive images represent digital image data on the disk, and the index print is either adhered to the disk or printed directly on the disk.

Accordingly, claims 39-40 are also believed to be allowable.

B. The rejection of claims 8-40 under 35 USC 103(a) as being unpatentable over Otake et al., Ishikawa et al. and Wess.

i. Argument for independent claim 8.

Claim 8 requires a method for creating an index print label for a digital image storage disk. The method of claim 8 comprises the steps of digitizing images to produce digital image data; storing the digital image data on a first surface of the digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the disk are not readable by a human; and providing, on a second surface of the disk, positive images that correspond to the digital image data, so that each of the positive images directly digitally represent the photographic images stored on the disk, and the positive images are provided on the second surface so as to be viewable by a human holding the disk. Claim 8 further requires that the positive images be provided on the disk so as to define a plurality of parallel rows on the disk, with at least a first row of the plurality of rows beginning at a first location on the disk and ending at a second location on the disk that is between the first location and a center axis of the disk, such that the second location is on a first side of the center

axis; and at least a second row of the plurality of rows beginning at a third location and ending at a fourth location on the disk that is opposite to the third location, such that the fourth location is on a second side of the center axis which is opposite to the first side.

The references to Otake et al, Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to anticipate or make obvious the specific features required by claim 8. As noted above, the claimed invention provides for a method of creating an index print with viewable positive images on one surface of a disk that permits a person to view or read the positive images while holding the disk. These positive images are provided in specific layouts or arrangements on the disk, and represent the photographic images stored on a second opposing surface of the disk in the form of digital image data.

A feature of the present invention relates to the ability of a person to easily and quickly pick up a storage disk or photo CD and at a glance know what images are stored on the photo CD or disk. This is particularly useful in the area of photo CDs or storage disks where the images are stored as digital image data and not readily readable or viewable by a human. Further, with the specific structure and method of the present invention, the index print is provided on the storage disk or CD. This overcomes problems with prior techniques in which the index print is provided on a separate card or case which holds the CD or disk and can become separated from the CD or disk. In a still further feature of the present invention, given the nature of photo CDs and storage disks, a user can quickly glance at the index print on the photo CD or disk, determine quickly that it is the disk or CD that he or she wishes to use, and quickly insert the disk into a computer to view the images which correspond to the positive images on the index print.

The reference to Otake et al. shows a basic index sheet and the provision of the index sheet on a separate case. Otake et al. differs from the claimed invention in that the index sheet is provided separately from the image-recording medium.

The reference to Ishikawa et al. was cited show the concept of applying an index print either by printing directly on an item or by affixing an

adhesive label with an index print thereon. However, the reference to Ishikawa et al. has the same drawbacks as Otake et al., since the reference to Ishikawa et al. discloses the concept of providing an index print on a medium that is not the medium that carries the images. More specifically, Ishikawa et al. discloses the concept of providing an index print on a film cartridge. This is different from the claimed invention in which the index print is provided on the same medium where the images are provided. In the arrangements of Otake et al. and Ishikawa et al., the casing or cartridge having the index print thereon can be separated from the disk or film which includes the images. Further, the reference to Ishikawa et al. does not disclose or suggest the claimed method which requires that the disk have a first surface with digital image data, and a second surface that opposes the first surface with index images (that directly represent or replicate the images stored on the disk or CD), in a manner in which the images on the index print can be viewable by human while holding the disk. Therefore, modifying the reference to Otake et al. with the teaching of Ishikawa et al. would not provide for the claimed invention, since the teaching of Ishikawa et al. is similar to Otake et al. in the sense that the positive images are provided on an element that is not the element onto which the images are stored.

The reference to Wess was cited to show the concept of providing an index print on an image-recording medium. In Wess, an index print is provided on the end of the disclosed image recording medium which is a developed roll of film, such that the developed roll of film along with the index print can be rolled back into a cassette. It is noted that the cassette of Wess is of the type having a door 119 that can be rotated from a closed position to an open position by inserting a drive member into a keyway 117. Therefore, in the reference to Wess, the film having the index print thereon is intended to be kept within the cassette until the film is pulled from the cassette by utilizing a special drive-member type tool.

Regarding the reference to Wess referring to Otake et al. (column 1, lines 18-54), Applicants note that the specific mention of Otake et al. in the reference to Wess refers to Fig. 11 of Otake et al. which illustrates a container for an index sheet together with photographic film and printed photographs. Absent

Applicants' disclosure, there would have been no teaching or suggestion of providing a photo CD or disk with an index sheet having the positive images provided in the layout or arrangement specifically required by the claimed invention.

That is, the reference to Otake et al. discloses providing an index sheet on an element that is separate from the media on which the image data is stored. The reference to Ishikawa et al. parallels Otake et al. in that it also teaches the concept of providing the index sheet on an element (a cartridge) that is different from the media which has the images. The reference to Wess which was cited to show the concept of an index sheet on an image-carrying medium does not provide for the specific method and structure of the claimed invention. In Wess the medium is a developed roll of film and the index sheet does not include the claimed layout or arrangement of positive images on a disk as claimed. Absent Applicants' disclosure, there would be no teaching, suggestion or motivation to provide a first surface of a disk with digital image data, and a second opposing surface of the disk with an index print with images in a specific layout or arrangement that effectively uses the surface of the disk; such that the positive images exactly represent and replicate the content of the digital image data and are viewable while holding the disk.

Applicant notes that in conventional labels on a CD, the label only includes a title or broadly describes what is stored on the CD. There is no applied reference that shows the claimed disk with digital image data on one side and positive images (in a specific layout or arrangement) that exactly represent the digital image data on the opposing side of the disk, wherein the positive images are provided in a manner that permits a user to pick up the disk and easily see exactly what images are stored on the disk.

Further, the reference to Wess does not show a first surface with digital image data and a second surface opposing the first surface with the index sheet. Applicants note that it would not have been obvious to provide the index sheet in Wess on the opposing second surface of the film since there is no teaching or motivation in Wess for such an arrangement, and the provision of the index sheet of Wess on an opposing surface of the film would obscure the exposed

images on the negative. Additionally, a plurality of cassettes such as disclosed in Wess where the index sheet is provided on a film that is inserted in the cartridge would make it difficult to distinguish one cartridge from another without having to remove the film from the cassette.

Also, as noted above, the pending claims include limitations with regard to the layout or arrangement of the positive images on the disk in a manner which achieves an effective utilization of the space on the disk, as well as permits a user to hold the disk and view the positive images representative of the digital image data on the disk. In the Final Rejection, it is suggested that the specific layouts are merely related to "printed matter". As noted in the discussion involving the rejection based on Kahle and Kraft et al., Applicants disagree since the claims are specifically directed to either a method of creating an index print and/or images for a digital image storage disk or the digital storage disk having an index print and/or images thereon. Therefore, the combination of the index print and the disk are both articles of manufacture and there is a clear relationship between the index print, the images on the index print and the digital image data that is stored on the disk. Furthermore, by providing the layout or arrangement of the positive images in the manner as required by claim 8 and discussed above, it is possible to effectively use the space on the disk, and further provide for a faster and easier way to identify the digital images that are stored on a disk by viewing the index print images. Therefore, it is clear that both the method of creating the index print for a storage disk having the image layout or arrangement as noted in the claim, as well as the digital image disk itself provide for a useful, concrete and tangible result. This results in a disk with a specific layout or arrangement of positive images that utilizes the space on the disk in an efficient manner to provide for an easy way to identify digital images on the disk. Further, it is clear that there is a relationship between the arrangement of the positive images on the disk and the disk itself, and that this arrangement distinguishes the claimed invention from the applied references. That is, the specific provision of the location of the positive images with regard to parallel rows, the center of the disk and orthogonal planes relative to the disk are not believed to be shown or suggested in any of the applied references.

Accordingly, the references to Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 8.

ii. Argument for dependent claims 9-10.

Claims 9-10 depend from claim 8 and set forth further unique features of the present invention which are also not believed to be shown or suggested in the applied references. Each of claims 9-10 set forth additional features of the positive images with respect to providing them on the digital image storage disk. More specifically, each of claims 9 and 10 require that the positive images be provided on a first portion of the second surface of the disk, and that indicia is provided on a second portion of the second surface of the disk as shown in Fig. 1. Further, claim 9 requires that the images be printed directly on the disk, while claim 10 requires that the images be provided on a label that can be adhered to the disk. Thus, each of claims 9 and 10 further elaborate on the feature of providing images on the disk, and require the provision of indicia separate from the positive images on the disk. None of the applied references, whether considered individually or in combination, are believed to show or suggest the specific combination of features required by claims 9 and 10.

More specifically, none of the applied references show or suggest the combination of positive images that represent digital information stored on a disk being provided on a first portion of the disk, and indicia being provided on a second portion of the disk. Therefore, claims 9 and 10 are also allowable.

iii. Argument for independent claim 11.

Independent claim 11 relates to a digital image storage disk that comprises a first surface containing digital image data representing a plurality of photographic images, such that the images represented by the data stored on the first surface of the disk are not readable by a human; and an array of printed images on a second surface of the digital image storage disk, with the printed

images corresponding to the plurality of images stored on the first surface of the disk as the digital image data. As further required by claim 11, the printed images provided on the second surface of the disk are provided thereon so as to be viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk. Claim 11, like claim 8 sets forth that the images are provided so as to define a plurality of parallel rows on the disk, with at least a first row of the plurality of rows beginning at a first location on the disk that is in the vicinity of a first point on an outer perimeter of the disk, and ending on a second location on a disk which is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis. Claim 11 further requires that at least the second row of the plurality of rows begins at a third location on the disk that is a vicinity of a second point on the outer perimeter of the disk and ends at a fourth location on a disk that is opposite to the third location and is in a vicinity of a third point on the outer parameter of the disk, such that the fourth location is on a second side of the center axis which is opposite to the first side.

The reference to Otake et al. shows a basic index sheet and the provision of the index sheet on a separate case. Otake et al. differs from the claimed invention in that the index sheet is provided separately from the image-recording medium.

The reference to Ishikawa et al. has the same drawbacks as Otake et al., since the reference to Ishikawa et al. discloses the concept of providing an index print on a medium that is not the medium that has the images provided thereon. More specifically, Ishikawa et al. discloses the concept of providing an index print on a film cartridge. This is different from the claimed invention in which the index print and/or image is provided on the same medium where the images are stored. In the arrangements of Otake et al. and Ishikawa et al., the casing or cartridge having the index print thereon can be separated from the disk or film which includes the images. Further, the reference to Ishikawa et al. does not disclose or suggest the claimed apparatus with regard to the structure of the disk having with a first surface with digital image data, and a second surface that opposes the first surface with index images (that directly represent or replicate the

images stored on the disk). Therefore, modifying the reference to Otake et al. with the teaching of Ishikawa et al. would not provide for the claimed invention, since the teaching of Ishikawa et al. is similar to Otake et al. in the sense that the positive images are provided on an element that is not the element that has the images provided thereon. The reference to Wess discloses an index print provided on the end of a developed roll of film, such that the developed roll of film along with the index print can be rolled back into a cassette.

The reference to Wess does not show the specific structure of the claimed invention. That is, in Wess the index sheet does not include the claimed layout or arrangement of positive images. Therefore, claim 11 is believed to be allowable over the applied references.

iv. Argument for dependent claims 12-13.

Dependent claims 12-13 set forth further unique features of the disk of claim 12. More specifically, claim 12 requires that the array of printed images be printed directly onto a first portion of the second surface of the disk and that indicia be provided on a second portion of the second surface of the disk. Claim 13 requires that the photographic images be printed on a label sticker that is affixed to a first portion of the second surface of the disk, and that indicia be provided on a second portion of the second surface of the disk.

The applied references, whether considered individually or in combination, are not believed to show or suggest the specific combination of images being printed on a first portion of a disk and indicia being provided on a second portion of a disk in the manner as required by claims 12 and 13.

v. Argument for dependent claim 14.

Claim 14 sets forth a further feature of the disk wherein each image in the array contains an image number that corresponds to a location of the digital image data on a disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific feature of a disk having positive images thereon, wherein an image number that corresponds to a location of the digital image data on the disk as provided for each image.

vi. Argument for independent claim 15.

Independent claim 15 relates to digital image storage disk that comprises a first side for digital information, a second side opposite the first side and an index print provided on a second surface of the second side. The index print includes a plurality of positive images that visually directly represent the plurality of photographic images stored on the first surface of the disk. Claim 15 further requires that the positive images are provided on the disk so as to define a plurality of rows, with at least a first row of the plurality on rows beginning at a first location on the disk and ending at a second location of the disk which is between the first location and a center axis of the disk, such that the second location is on a first side of the center axis, and at least a second row of the plurality of rows beginning at a third location on the disk and ending at a fourth location on the disk that is opposite to the third location, such that the fourth location is on a second side of the center axis which is opposite to the first side.

As noted above, the applied references to Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the specific combination of features required by claim 15. More specifically, both Otake et al. and Ishikawa et al. disclose providing an index sheet on an element which is separate from the element that has the images thereon. The reference to Wess does not show or suggest the combination of the disk having images thereon that represent digital data stored on the disk, wherein the images are provided in the specific layout or arrangement as claimed.

Accordingly, Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 15.

vii. Argument for dependent claim 16.

Claim 16 depends from 15 and sets forth a further unique feature of the index print. More specifically, claim 16 requires that the index print define an arcuate shape. This specific features takes advantage of the geometry of the disk.

The features of claim 16 are not believed to be shown or suggested in the applied references. Therefore, claim 16 is believed to be allowable.

viii. Argument for dependent claims 17-18.

Claim 17 requires that the index print be adhered to a surface of the disk, while claim 18 requires that the index print be printed directly onto the surface of the disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the claimed feature of an index print with positive images thereon that is adhered or printed directly on the disk in the manner as required by claims 17 and 18.

Accordingly, claims 17 and 18 are also believed to be allowable.

ix. Argument for independent claim 19

Claim 19 relates to a method for creating an index print label for a digital image storage disk. The method of claim 19 requires the steps of digitizing photographic images to provide digital image data representative of the image; storing the data on a first surface of the disk; and providing on a second surface of the disk positive images that correspond to the data so that each of the positive images directly represent the images stored on the disk and are viewable by a human while holding the disk. Claim 19 further requires that the positive images be provided on the disk so as to define a plurality of rows on the disk, with at least two orthogonal planes extending along a center axis of the disk. At least the first row of the plurality of rows defines a first longitudinal axis which is perpendicular to one of the orthogonal planes, with the first row beginning and ending on one side of the one orthogonal plane; and at least the second row of the plurality of rows defines a second longitudinal axis which is perpendicular to the one orthogonal plane, with the second row beginning on one side of the one orthogonal plane and ending on an opposite side of the one orthogonal plane.

The general features of the references to Otake et al., Ishikawa et al. and Wess have been discussed above with regard to claim 1. More specifically, both Otake et al. and Ishikawa et al. disclose providing an index sheet on an element which is separate from the element that has the images thereon. The reference to Wess does not show or suggest the combination of the disk having images thereon that represent digital data stored on the disk, wherein the images are provided in the specific layout or arrangement as claimed.

The references to Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the specific combination of features required by claim 19, with regard to providing digital information on one side of the disk, providing positive images on a second

side of the disk that represents the digital information, and arranging the images in the specific manner on the surface of the disk as required by claim 19.

Accordingly, Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 19.

x. Argument for dependent claims 20 and 21.

Claims 20 and 21 depend from claim 19 and set forth further features with regard to placing the images on the disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific method of placing images on a disk (wherein the images represent positive images of digital information stored on the disk) as required by claims 20-21. Accordingly, these claims are also believed to be allowable.

xi. Argument for independent claim 22.

Claim 22 relates to a disk that includes a first surface with digital image information and a second surface with an array of printed images that correspond to the digital information. Claim 22 further requires the layout or arrangement of the images on the disk in a manner similar to claim 19.

The features of the references to Otake et al., Ishikawa et al. and Wess have been discussed above. The applied references, whether considered individually or in combination, are not believed to show or suggest the specific features of a disk having a first surface with digital information, and a second surface with positive images that correspond to the digital information, as well as the arrangement of the images on the disk in the manner as required by claim 22.

Accordingly, Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 22.

xii. Argument for dependent claims 23-24

Claims 23-24 set forth further unique features of the present invention which are also not believed to be shown or suggested in the applied references. More specifically, claims 23-24 set forth features of printing the

images directly on the disk or on a label sticker that is affixed to the disk. The above features in combination with the features set forth in claim 22 are not believed to be shown or suggested in the applied references. Therefore, claims 23-24 are believed to be allowable.

xiii. Argument for dependent claim 25.

Claim 25 relates to each image in the array containing an image number that corresponds to a location of the image data on the disk. The applied references are not believed to show or suggest the features of claim 25 in combination with the features of claim 22 as noted above. Therefore, claim 25 is believed to be allowable.

xiv. Argument for independent claim 26.

) Claim 26 relates to a disk that has a first side with digital information and a second side with a second surface. Claim 26 further requires that an index print be provided on the second surface of the disk, with the index print having a plurality of positive images that correspond to the images that are stored on the first surface of the disk. Claim 26 further requires that the positive images be arranged in a manner similar to claim 22 with regard to the images being in a plurality of rows, with one of the rows beginning and ending on one side of the an orthogonal plane through the center of the disk, and a second row extending to both sides of the orthogonal plane.

For the reasons noted above, the applied references to Otake et al., Ishikawa et al. and Wess are not believed to show or suggest the combination of a disk with a first side that includes digital data, a second side that includes an index print with positive images that correspond to the digital data, and an arrangement of the positive images on the disk so as to define a plurality of rows, with a first row being on one side of an orthogonal plane that extends through the center of the disk, and a second row extending to both sides of the orthogonal plane.

Accordingly, claim 26 is believed to be allowable over Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination.

xv. Argument for dependent claim 27.

Claims 27 sets forth a further feature with respect to the index print and requires that the index print define an arcuate shape. This feature, in combination with the features of claim 26 is not shown or suggested in the applied references.

xvi. Argument for dependent claims 28-29.

Claim 28 sets forth that the index print is adhered to the second surface of the disk, and claim 29 sets forth that the index is printed directly on the second surface of the disk. The applied references, whether considered individually or in combination, are not believed to show or suggest the further features of claims 28-29.

xvii. Argument for independent claim 30.

Claim 30 relates to method of creating an index print label for a digital image storage disk. The method of claim 30 requires digitizing photographic images to produce digital image data; storing the digital image data on a first surface of the disk; and providing positive images on a second surface of the disk that correspond to the digital image data. Claim 30 further requires that at least two orthogonal claims be defined along a center axis of the disk, with at least a first positive image being located on a first side of one of the orthogonal planes, and at least a second positive image being on a second side of the one orthogonal plane that is opposite to the first side.

The specifics of the references to Otake et al., Ishikawa et al. and Wess and their relationship to the subject matter of the present invention has been discussed above. It is noted that the references to Otake et al., Ishikawa et al. and Wess do not show or suggest the claimed features of the present invention, including the combination of providing digital data on one surface of the disk, providing positive images on a second surface of the disk that correspond to the digital data, and arranging the positive images on the disk, with respect to an orthogonal plane along a center axis of the disk, in a manner in which a first positive image is on one side of the orthogonal plane, and a second positive image is on a second side of the orthogonal plane.

Accordingly, Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 30.

xviii. Arguments for dependent claims 31-32.

Dependent claims 31-32 require a specific method for printing or providing the images on a disk. Claim 31 requires that the images be printed directly on the disk while claim 32 requires that the images be provided on a label sticker and adhered to the disk. The features of claims 31-32 are not believed to be shown or suggested in the applied references.

xix. Argument for independent claim 33

Claim 33 relates to a digital image storage disk which includes a first surface that contains digital image data representing a plurality of photograph images; and an array of printed images on a second surface of the disk, with the printed images corresponding to the plurality of photographic images stored on the first surface of the disk as digital image data and being provided so as to be readable by a human while holding the disk. Claim 33 further requires that the images be arranged so that a first image can appear on one side of an orthogonal plane and a second image can appear on a second side of the orthogonal plane.

The references to Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the specific features of claim 33. The particulars of the references to Otake et al., Ishikawa et al. and Wess are discussed with reference to claim 1. With regard to claim 33, the references to Otake et al., Ishikawa et al. and Wess do not show or suggest the combination of a disk that has digital image data on a first surface; an array of printed images on a second surface (where the printed images are a replication of the digital data); and an arrangement of the images on the surface of the disk, such that at least one of the images is on a first side of an orthogonal plane defined along a center axis of the disk, and at least a second image is on second side of orthogonal plane.

Accordingly, claim 33 is believed to be allowable over the references to Otake et al., Ishikawa et al. and Wess,

xx. Argument for dependent claims 34-35.

Claim 34 relates to the images being printed directly on the disk, while claim 35 relates to the feature of the images being provided on a label sticker that is affixed to the disk. These claims set forth further features with regard to the placement of the images on the disk that are not believed to be shown or suggested in the applied references. Therefore, claims 34-35 are also allowable.

xxi. Argument for dependent claim 36.

Claim 36 relates to the feature of each image having an image number that corresponds to a location of the digital image data on a disk. The applied references are not believed to show or suggest the features of claim 36.

xxii. Argument for independent claim 37.

Independent claim 37 relates to digital image storage disk that includes a first side with digital image data and a second side that has a surface onto which an index print having a plurality of positive images is provided. The plurality of positive images correspond to the digital image data on the disk. Claim 37 further requires an arrangement of the images on the disk where at least a first image is on one side of an orthogonal plane that is defined along a center axis of the disk, and a second image is on an opposite side of the orthogonal plane.

The references to Otake et al., Ishikawa et al. and Wess are not believed to show or suggest the specific combination of features required by claim 37, including the concept of having a disk with a first side with digital image data, a second side with an index print that includes positive images that correspond to the digital data, and an arrangement of the images on the disk so that at least one image is on a first side of an orthogonal plane defined along a center of the disk, and at least a second image is on a second side of the orthogonal plane.

Accordingly, Otake et al., Ishikawa et al. and Wess, whether considered individually or in combination, are not believed to show or suggest the features of claim 37.

xxiii. Argument for dependent claim 38.

Claim 38 requires that the index print define an arcuate shape. The applied references are not believed to show or suggest the specific combination of features with regard to claim 38 and claim 37 from which claim 38 depends.

xxiv. Argument for dependent claims 39-40.

Claims 39-40 set forth further features with respect to the index print either being adhered to the surface of the disk or being printed directly onto the surface of the disk. The applied references are not believed to show or suggest the combination of an index print with positive images, wherein the positive images represent digital image data on the disk, and the index print is either adhered to the disk or printed directly on the disk.

Accordingly, claims 39-40 are also believed to be allowable.

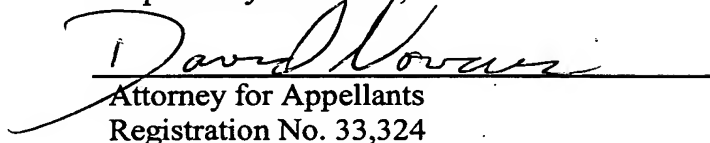
VIII. Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 8-40.

David A. Novais/l
Telephone: 585-588-2727
Facsimile: 585-477-1148
Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Respectfully submitted,



Attorney for Appellants
Registration No. 33,324

Appendix I - Claims on Appeal

8. A method for creating an index print label for a digital image storage disk, the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images;

storing the digital image data on a first surface of a digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human; and

providing, on a second surface of the digital image storage disk, positive images which correspond to the digital image data, so that each of the positive images directly visually represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk;

wherein:

said positive images are provided on said digital image storage disk so as to define a plurality of parallel rows on said disk, at least a first row of said plurality of rows beginning at a first location on said disk and ending at a second location on said disk which is between said first location and a center axis of said disk, such that said second location is on a first side of said center axis; and at least a second row of said plurality of rows beginning at a third location on said disk and ending at a fourth location on said disk that is opposite to said third

location, such that said fourth location is on a second side of said center axis which is opposite to said first side.

9. The method of claim 8, wherein the positive images are provided by printing them directly on a first portion of the second surface of the digital image storage disk and indicia is provided on a second portion of the second surface of the digital image storage disk.

10. The method of claim 8, wherein the positive images are provided by printing a label sticker and adhering the label sticker to a first portion of the second surface of the digital image storage disk and indicia is provided on a second portion of the second surface of the digital image storage disk.

11. A digital image storage disk comprising:

a first surface containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human; and

an array of printed images on a second surface of the digital image storage disk, the printed images corresponding to the plurality of photographic images stored on the first surface of the digital image storage disk as said digital image data, said printed images being provided on said second surface of the digital image storage disk so as to be viewable by a human while holding the digital image storage disk, so as to provide for a human readable representation of

each of the photographic images stored on the first surface of the digital image storage disk;

wherein:

said positive images provided on said digital image storage disk are provided on said disk so as to define a plurality of parallel rows on said disk, at least a first row of said plurality of rows beginning at a first location on said disk that is in a vicinity of a first point on an outer perimeter of said disk and ending at a second location on said disk which is between said first location and a center axis of said disk, such that said second location is on a first side of said center axis; and at least a second row of said plurality of rows beginning at a third location on said disk that is in a vicinity of a second point on the outer perimeter of said disk and ending at a fourth location on said disk that is opposite to said third location and is in a vicinity of a third point on the outer perimeter of the disk, such that said fourth location is on a second side of said center axis which is opposite to said first side.

12. The disk of claim 11, wherein the array of printed images representing the plurality of photographic images is printed directly onto a first portion of the second surface of the disk and indicia is provided on a second portion of the second surface of the digital image storage disk.

13. The disk of claim 11, wherein the array of printed images representing the plurality of photographic images is printed on a label sticker that

is affixed to a first portion of the second surface of the disk and indicia is provided on a second portion of the second surface of the digital image storage disk.

14. The disk of claim 11, wherein each image in the array contains an image number which corresponds to a location of the digital image data on the disk.

15. A digital image storage disk comprising:

a first side which includes a first surface adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface; and

an index print provided on said second surface of the disk, said index print comprising a plurality of positive images which visually directly represent the plurality of photographic images stored on the first surface of the disk as digital image data, said index print being provided on said second surface of said disk so that said plurality of positive images are viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk;

wherein:

said positive images provided on said digital image storage disk are provided on said disk so as to define a plurality of parallel rows on said disk, at least a first row of said plurality of rows beginning at a first location on said disk

and ending at a second location on said disk which is between said first location and a center axis of said disk, such that said second location is on a first side of said center axis; and at least a second row of said plurality of rows beginning at a third location on said disk and ending at a fourth location on said disk that is opposite to said third location, such that said fourth location is on a second side of said center axis which is opposite to said first side.

16. A disk according to claim 15, wherein said index print defines an arcuate shape.

17. A disk according to claim 15, wherein said index print is a label that is adhered to the second surface of the disk.

18. A disk according to claim 15, wherein said index print is printed directly onto the second surface of the disk.

19. A method for creating an index print label for a digital image storage disk, the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images;

storing the digital image data on a first surface of a digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human; and

providing, on a second surface of the digital image storage disk, positive images which correspond to the digital image data, so that each of the positive images directly represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk;

wherein:

said positive images are provided on said digital image storage disk so as to define a plurality of rows on said disk, and at least two orthogonal planes extend along a center axis of said disk, at least a first row of said plurality of rows defines a first longitudinal axis which is perpendicular to one of said orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, and at least a second row of said plurality of rows defines a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on said one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

20. The method of claim 19, wherein the positive images are provided by printing them directly on the second surface of the digital image storage disk.

21. The method of claim 19, wherein the positive images are provided by printing a label sticker and adhering the label sticker to the second surface of the digital image storage disk.

22. A digital image storage disk comprising:

a first surface containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human; and

an array of printed images on a second surface of the digital image storage disk, the printed images corresponding to the plurality of photographic images stored on the first surface of the digital image storage as said digital image data, said printed images being provided on said second surface of the digital image storage disk so as to be viewable by a human while holding the digital image storage disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the digital image storage disk;

wherein:

said positive images are provided on said digital image storage disk so as to define a plurality of rows on said disk, and at least two orthogonal planes extend along a center axis of said disk, at least a first row of said plurality of rows defining a first longitudinal axis which is perpendicular to one of said two orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, at least a second one of said plurality of rows defining a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

23. The disk of claim 22, wherein the array of printed images representing the plurality of photographic images is printed directly onto the second surface of the disk.

24. The disk of claim 22, wherein the array of printed images representing the plurality of photographic images is printed on a label sticker that is affixed to the second surface of the disk.

25. The disk of claim 22, wherein each image in the array contains an image number which corresponds to a location of the digital image data on the disk.

26. A digital image storage disk comprising:

a first side which includes a first surface adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface; and

an index print provided on said second surface of the digital image storage disk, said index print comprising a plurality of positive images which correspond to the plurality of photographic images stored on the first surface of the digital image storage disk as digital image data, said index print being provided on said second surface of said digital image storage disk so that said plurality of positive images are viewable by a human while holding the digital

image storage disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the digital image storage disk;

wherein

said positive images are provided on said digital image storage disk so as to define a plurality of rows on said disk, and at least two orthogonal planes extend along a center axis of said disk, at least a first row of said plurality of rows defining a first longitudinal axis which is perpendicular to one of said two orthogonal planes, said first row beginning and ending on one side of said one orthogonal plane, at least a second row of said plurality of rows defining a second longitudinal axis which is perpendicular to said one orthogonal plane, said second row beginning on said one side of said one orthogonal plane and ending on an opposite second side of said one orthogonal plane.

27. A disk according to claim 26, wherein said index print defines an arcuate shape.

28. A disk according to claim 26, wherein said index print is a label that is adhered to the second surface of the disk.

29. A disk according to claim 26, wherein said index print is printed directly onto the second surface of the disk.

30. A method for creating an index print label for a digital image storage disk, the method comprising the steps of:

digitizing photographic images to produce digital image data representative of the photographic images;

storing the digital image data on a first surface of a digital image storage disk, such that the photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human; and

providing, on a second surface of the digital image storage disk, positive images which correspond to the digital image data, so that each of the positive images directly represent the photographic images stored on the digital image storage disk, said positive images being provided on said second surface so as to be viewable by a human while holding the digital image storage disk;

wherein at least two orthogonal planes are defined along a center axis of said disk, at least a first positive image of said positive images being located on a first side of one of said orthogonal planes, and at least a second positive image of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

31. The method of claim 30, wherein the positive images are provided by printing them directly on the second surface of the digital image storage disk.

32. The method of claim 30, wherein the positive images are provided by printing a label sticker and adhering the label sticker to the second surface of the digital image storage disk.

33. A digital image storage disk comprising:

a first surface containing digital image data representing a plurality of photographic images, such that the photographic images represented by the digital image data stored on the first surface of the disk are not readable by a human; and

an array of printed images on a second surface of the disk, the printed images corresponding to the plurality of photographic images stored on the first surface of the disk as said digital image data, said printed images being provided on said second surface of the disk so as to be viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk;

wherein at least two orthogonal planes are defined along a center axis of said disk, at least a first positive image of said positive images being located on a first side of one of said orthogonal planes, and at least a second positive image of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

34. The disk of claim 33, wherein the array of printed images representing the plurality of photographic images is printed directly onto the second surface of the disk.

35. The disk of claim 33, wherein the array of printed images representing the plurality of photographic images is printed on a label sticker that is affixed to the second surface of the disk.

36. The disk of claim 33, wherein each image in the array contains an image number which corresponds to a location of the digital image data on the disk.

37. A digital image storage disk comprising:

a first side which includes a first surface adapted to store a plurality of photographic images as digital image data, such that said photographic images stored on said first surface as digital image data are not viewable by a human;

a second side opposite to said first side, said second side including a second surface; and

an index print provided on said second surface of the disk, said index print comprising a plurality of positive images which correspond to the plurality of photographic images stored on the first surface of the disk as digital image data, said index print being provided on said second surface of said disk so that said plurality of positive images are viewable by a human while holding the disk, so as to provide for a human readable representation of each of the photographic images stored on the first surface of the disk;

wherein at least two orthogonal planes are defined along a center axis of said disk, at least a first positive image of said positive images being

located on a first side of one of said orthogonal planes, and at least a second positive image of said positive images being provided on a second side of said one orthogonal plane which is opposite to said first side.

38. A disk according to claim 37, wherein said index print defines an arcuate shape.

39. A disk according to claim 37, wherein said index print is a label that is adhered to the second surface of the disk.

40. A disk according to claim 37, wherein said index print is printed directly onto the second surface of the disk.

Appendix II – Related Proceedings

Attached is DECISION ON APPEAL for US Serial No. 09/176,143 (Docket 83800) mailed June 27, 2003; Appeal No. 2001-2214.

DAN

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

82800/DAN

UNITED STATES PATENT AND TRADEMARK OFFICE

EASTMAN KODAK CO.

JUL 15 2003

PATENT LEGAL STAFF

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. TRUC
and
CAL A. WRIGHT

Appeal No. 2001-2214
Application 09/176,143

ON BRIEF

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KINNEY & LANGE, P.A.

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JUN 27 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Entered by NAR

Before THOMAS, RUGGIERO, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-7, which are all of the claims pending in the present application.

The disclosed invention relates to an index print label for a compact disk (CD) that is used to store photographs. Photographic images are digitized to produce digital data which is stored on the CD, the digital data also being used to create

Appeal No. 2001-2214
Application No. 09/176,143

an index print containing thumbnail images of the photographs stored on the CD. The index print is subsequently affixed to the top surface of the CD either by printing on a label adhered to the disk surface, or by being directly printed on the surface of the disk.

Representative claim 1 is reproduced as follows:

1. A method for creating a CD index print label comprising:

digitizing photographic images to produce digital image data;

storing the digital image data on a digital disk medium;

providing, on a disk surface of the digital disk medium, images based upon the digital image data, so that the images represent contents stored on the digital disk medium.

The Examiner relies on the following prior art:

Otake et al. (Otake)	4,805,039	Feb. 14, 1989
Ishikawa et al. (Ishikawa)	5,617,171	Apr. 01, 1997
Wess	5,828,442	Oct. 27, 1998
		(filed Feb. 27, 1996)

Claim 1-7 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Otake, Ishikawa, and Wess.

Appeal No. 2001-2214
Application No. 09/176,143

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and the Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

¹The Appeal Brief (revised) was filed July 5, 2000 (Paper No. 14). In response to the Examiner's Answer mailed August 3, 2000 (Paper No. 15), a Reply Brief was filed October 6, 2000 (Paper No. 16), which was acknowledged and entered by the Examiner in the communication dated October 13, 2000 (Paper No. 17).

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the art the obviousness of the invention as set forth in claims 1-7. Accordingly, we affirm.

Appellants indicate (Brief, page 2) that the claims on appeal stand or fall together as a group. Consistent with this indication, Appellants' arguments are directed solely to features which are set forth in independent claim 1. Accordingly, we will select independent claim 1 as the representative claim for all the claims on appeal, and claims 2-7 will stand or fall with claim 1. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

With respect to representative independent claim 1, the Examiner, as the basis for the obviousness rejection, proposes to modify the disclosure of the Otake reference which describes the formation of an index print which provides thumbnail images to catalog photographic images stored on a recording medium such as a video disc. According to the Examiner (Answer, page 4), Otake discloses the claimed invention except that "the index print is provided separately from the image recording medium." To address this deficiency, the Examiner turns to the Wess reference which, in suggesting a solution to the problem of the index print becoming separated from the recording medium, describes a

technique in which the index print is directly affixed to the recording medium. In the Examiner's analysis (Id.), the skilled artisan would have been motivated and found it obvious to attach an index print directly to the video disk recoding medium in Otake "for the benefit of alleviating the 'fear that the index print will become separated from the image recording medium' as taught by Wess." The Ishikawa reference is further added to the combination of Otake and Wess as providing a teaching of the equivalence of applying an index print by printing directly on a recording medium or by applying a printed label to the recording medium.

After reviewing the Examiner's analysis, it is our view that such analysis carefully points out the teachings of the Otake, Wess, and Ishikawa references, reasonably indicates the perceived differences between this prior art and the claimed invention, and provides reasons as to how and why the prior art teachings would have been modified and/or combined to arrive at the claimed invention. In our opinion, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut

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the Examiner's prima facie case of obviousness.

Appellants' arguments in response to the obviousness rejection initially assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the applied prior art references in light of the arguments of record, we find Appellants' assertions to be unpersuasive. In our view, Appellants' arguments unpersuasively focus on the individual differences between the limitations of representative claim 1 and each of the applied references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of Otake, Wess, and Ishikawa. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F. 2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellants contend that, in contrast to the claimed invention, Otake discloses an index print kept separate from the recording medium, the teaching of directly attaching an index print to a recording medium is provided by Wess. Further, although Appellants contend that Wess describes an index print associated with a filmstrip, a clear teaching of associating an index print with a photo disk is provided by Otake.

We further find to be unpersuasive Appellants' further argument (Brief, pages 5-8; Reply Brief, pages 1 and 2) that the Examiner has not established a proper motivation for the proposed combination of references since the references actually teach away from each other. As pointed out by the Examiner (Answer, page 4), Wess makes a direct reference to Otake in providing a teaching of correcting the problem of an index print becoming separated from its associated recording medium by physically attaching the index print to the recording medium. Given the referencing of the Otake index print system in the disclosure of Wess, we find, in direct contrast to Appellants' contention that the references "teach away" from each other, compelling evidence that the references themselves would suggest their combination to the skilled artisan. We also find, Appellants' arguments to the

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arguments to the contrary notwithstanding, that, although the embodiment described in the detailed description of Wess is directed to a filmstrip cartridge, Wess suggests (Summary of the Invention, column 1, line 55 through column 2, line 8) a broader application of the disclosed invention to "image recording medium" in general which would encompass the video disc medium of Otake.

In view of the above discussion, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of representative claim 1, and claims 2-7 which fall with claim 1, based on the combination of Otake and Wess.² With respect to the limitations in representative claim 1, we consider the teachings of Ishikawa to be cumulative to those of Otake and Wess.

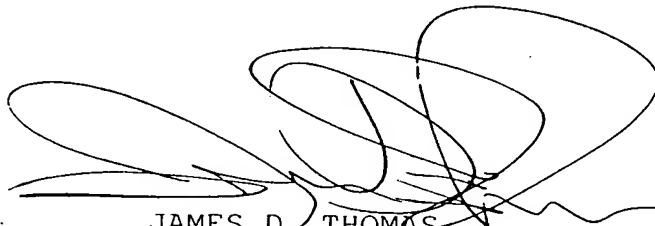
In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-7 is affirmed.

²The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

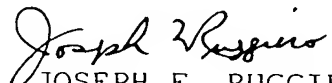
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED



JAMES D. THOMAS
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge



ANITA PELLMAN GROSS
Administrative Patent Judge

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KINNEY & LANGE, P.A.
The Kinney & Lange Building
312 South Third Street
Minneapolis, MN 55415-1002